



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Parra, Anthony C.
Serial No. : 10/075,082
Filed on : 02/13/2002
For : Casino Gaming Station
Group : 7564
Examiner : John H. Hotaling II
Attorney Docket No. : M223

**REPLY BRIEF
UNDER 37 CFR 41.41**

Hon. Commissioner of Patents and Trademarks
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

If any additional charges or fees must be paid in connection with this communication, they may be paid out of our deposit account No. 50-0783.

(A) STATUS OF CLAIMS

Claims 1 through 14 were filed with the original application. Claims 1 and 10 are the only independent claims. Claim 3 was canceled. All remaining claims stand rejected and are the subject of this appeal. The status of the various claims is as follows:

| <u>Claim No.</u> | <u>Status</u> | |
|------------------|---------------|----------|
| 1 | rejected | appealed |
| 2 | rejected | appealed |
| 3 | canceled | |
| 4 | rejected | appealed |
| 5 | rejected | appealed |
| 6 | rejected | appealed |
| 7 | rejected | appealed |
| 8 | rejected | appealed |
| 9 | rejected | appealed |
| 10 | rejected | appealed |
| 11 | rejected | appealed |
| 12 | rejected | appealed |
| 13 | rejected | appealed |
| 14 | rejected | appealed |

(B) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

I. Whether claims 1 and 10 are unpatentable under 35 USC 103(a) over Walsh (US Patent no. 5,726,706) in view of Wilton (US Patent no. 3,643,345).

II. Whether claim 2 is unpatentable under 35 USC 103(a) over Walsh in view of Wilton and in further view of Wynn et al (US Patent no. 5,971,271).

III. Whether claims 4, 7, and 12 are unpatentable under 35 USC 103(a) over Walsh in view of Wilton and in further view of Sines et al (US Patent no. 6,270,404).

IV. Whether claim 5 is unpatentable under 35 USC 103(a) over Walsh in view of Wilton in further view of Parra US patent 5,839,960).

V. Whether claims 6 and 11 are unpatentable under 35 USC 103(a) over Walsh in view of Wilton in further view of Jones II (US patent 6,154,131).

VI. Whether claims 8, 9, 13, 14 are unpatentable under 35 USC 103(a) over Walsh in view of Wilton in further view of Breeding et al (US Patent no. 6,299,534).

VII. Whether claims 1 and 10 and the amendment to the specification filed August 13, 2004 fail to comply with the written description requirement and constitute new matter under 35 USC 112.

(C) ARGUMENT

The present invention is a moveable gaming table and associated canopy for use by the casino gaming industry. As explained in the specification (Background and Summary of Invention) a typical casino floor is laid out in sections, each of which is devoted to a certain game of chance. Each game of chance has its own game requirements, and its own surveillance requirement to prevent cheating at the table. Typically, surveillance cameras are embedded in the ceiling with their lenses positioned and oriented to provide a view of the game to remote supervisors. Because of the unique requirements of each game, it is difficult to change the mix of games in a casino. The present invention is a replaceable gaming table having associated therewith a freestanding canopy that is positionable above the gaming table and containing a surveillance camera for viewing the game on the table. Other aspects of the invention include a headset to be worn by the dealer to provide voice communication between the dealer and the remote supervisor.

The examiner has rejected claims 1 and 10 under 35 USC 103 as being unpatentable over Walsh in view of Wilton. The applicant reasserts his arguments in support of these claims as submitted in his Second Corrected Brief on Appeal. The applicant further states that the Walsh reference discloses a canopy suspended by rods or wires from a fixed point in the casino ceiling whereas the Wilton reference teaches a device for moving a camera across a horizontal surface to simulate the view of the ground below from an airplane in flight. There is no suggestion in Walsh that the canopy disclosed therein could be attached to the end of a mobile crane of the type disclosed by Wilson, nor is there any need in Wilton to conceal the crane

camera within a canopy as is disclosed by Walsh and therefore the references should not be combined to reject claims 1 and 10. The examiner cites the camera 3 of Wilton as being a "canopy," which it clearly isn't. Furthermore, contrary to the assertion of the examiner, the crane arm of Wilton is not a unitary member. With respect to the crane arm, the examiner asserts that "both members are fixedly attached thereto as they can firmly be set in position," and that "they are fixed to their bases as they cannot readily be removed," and that "they are still fixedly attached as they are not removable from system..." The claims do not make use of the word "fixed" or "fixedly." The examiner is presumably implying that the rotatable extendable boom of Wilton is somehow equivalent to a unitary member, which the applicant believes it is not. The examiner admits that "a casino would not require the movement and hinging that a movie studio would and that the crane could become integral," but the text of Wilton does not suggest or imply that such a modification would have any benefit. In fact, the modification suggested by the examiner would render the device of Wilton unsuitable for its intended purpose.

In his Brief on Appeal, the applicant has cited In re Gordon 221 USPQ 1125 at 1127 as holding that it cannot be obvious to modify a device in a manner that renders the device unsuited for its intended use. The claims of In re Gordon were directed to a blood filter having a blood inlet and blood outlet of the bottom of the filter, whereas the prior art cited by the Patent Office disclosed a gas filter having inlets and outlets at the upper end. The court said that the question was whether it was obvious "from a fair reading of the prior art reference as a whole to turn the prior art apparatus upside down." The court found that at least in part the prior art device relied upon

gravity and therefore there would be no motivation to turn the device upside down. The court went on to say that “the mere fact that the prior art could be so modified would not have made the modifications obvious unless the prior art suggested the desirability of the modification (citations noted), indeed if the French apparatus were turned upside down, it would be rendered in operable for its intended purpose.” Virtually the same words can be said with respect to the examiner’s reliance upon Wilton. The examiner dismisses Gordon by saying that Wilton is cited for a teaching that is known to support a structure with a base and an arm support over a table, thereby implying that the relevancy of the Wilton reference should be tested against some lesser standard than that set by Gordon. The examiner can’t have it both ways. If Wilton is cited as rendering claims 1 and 10 obvious, then the teaching of Wilton must pass the test of Gordon.

The examiner has gone much further than citing Wilton as teaching that it is known to support a structure with a base and an arm. The examiner has in fact cited Wilton as disclosing a unitary support member as is required by the claims, a much different device than disclosed by Wilton. The examiner dismisses the applicant’s invention of a free standing pedestal that supports a canopy having a camera embedded therein that records the play of a game of chance as being no more than a “design choice.” In response the applicant cites the Declaration of Parra, which was filed along with the Amendment filed by facsimile on February 18, 2004. Mr. Parra’s Declaration (Exhibit A) states that cameras have been used to record the play of games of chance since the 1970’s but in the thirty years that have elapsed, the industry has not developed a pedestal, canopy, camera device suitable for use with a

gaming table in accordance with the present invention. It is believed therefore that claims 1 and 10 are clearly patentable over the combination of Walsh and Wilton.

The applicant similarly reasserts his arguments as set forth in the Second Corrected Brief on Appeal as supporting claim 2. Claim 2 is dependent upon claim 1 and further adds a headset to be used by a dealer connected to a supervisor at a remote location to facilitate communication between the supervisor and the dealer. The applicant further points out that the present application was filed February 13, 2002, more than five years ago. During the last five years, there have been great advances in wireless technology and the examiner's statement that "it is well known in the art that dealers are in constant communication with their supervisors..." may presently be true, although the examiner has offered nothing to support his statement. Certainly patrons who can connect memories of visiting gambling casinos with a timeline will know that wireless communication devices that are now common were nonexistent a very short time ago. With the technology of communications advancing rapidly, it is unfair to judge the present application, filed five years ago, on present knowledge. Thomas Edison made two thousand attempts before inventing the light bulb, but the invention is very elementary to anyone with a knowledge of simple electricity. Certainly it would be unfair to have denied Edison a patent because his invention was obvious to one with subsequent knowledge.

With respect to claims 4, 7, and 12, the applicant again reasserts the arguments set forth in his Second Corrected Brief of Appeal.

With respect to claims 7 and 12, in relying upon the Sines reference, the examiner states that "wherein instead of displaying the cards of player as disclosed

by Sines, the system of Walsh could broadcast that which is being filmed.” The disclosure of Sines, however, is a device for playing a game and there is no disclosure that the device of Sines could be used to provide security in any fashion. The applicant believes that the examiner is relying on hindsight in constructing his arguments with respect to claims 7 and 12. The applicant also asserts that because of advancement in video technology, aspects of the invention may now seem common, when in fact the application was filed before such advancements became well known.

The applicant relies on the arguments set forth in his Second Corrected Brief on Appeal with respect to claims 5, 6, 8, 9, 11, 13, and 14.

RESPONSE TO EXAMINER’S NEW GROUND FOR REJECTION

The examiner has rejected claims 1 and 10 and the amendments to the Specification entered August 13, 2004 as being new matter and therefore failing to comply with the written description requirement under 35 USC 112 as a New Ground for Rejection. Specifically, the examiner objects to the portions of the amendment filed August 13, 2004 in which the Specification was amended to state that the member consisting of the post 52 and the extension 54 is a “unitary member,” (see copy of Amendment to Specification attached as “Exhibit B”). As part of the same Amendment, claims 1 and 10 were amended to include the term “unitary member...” Although the Amendment of August 13, 2004 was originally entered without a “new matter” objection, the examiner now believes that the words “unitary member” constitute new matter. The examiner asserts that the present Specification teaches

away from the post 52 and extension 54 being a unitary member and cites a portion of page 3 of the Specification which states in part that "the post 52 and extension 54 may have any of a number of configurations within the spirit of the invention." In making the forgoing argument, the examiner has totally disregarded the drawing of the device as depicted in Fig. 1 (attached as Exhibit C) and has cited his portions of the text out of context. Page 6 lines 5 through 11 of the Specification state as follows: "Position near the table is a pedestal 50 supporting an upwardly extending vertical post 52, the upper end of which supports a horizontally outwardly extending portion 54 at the end of which is a canopy 56. Although the pedestal 50 is depicted in Fig. 1 as having an arcuate configuration extending from the post 52 to the horizontal extension 54, the post 52 and extension 54 may have any of a number of configurations within the spirit of the invention." The pedestal 50 is provided with a base 55 having sufficient weight and ..." Fig. 1, and clearly depicts a free standing pedestal with an arm extending from the base that sweeps arcuately upwardly with the upper end extending outwardly over the adjacent table 11.

Although the indicia number for the pedestal 50 is directed to the base; it is clear from the text that the word "pedestal 50" applies to the entire upstanding device including the base, the post 52 and the extension 54. The Specification states that "base" bears indicia number 55 (page 6 line 11 of the Specification) but there is no indicia number 55 on Fig. 1. Fig. 1 clearly depicts the combined elements of the post 52 and extension 54 as a unitary member even though the word "unitary" is not used in the Specification. If the examiner is of the opinion that the specification and drawings teach away from the parts being unitary, the examiner must be able to


designate an exact point, and not an arbitrary point, which designates the end of post 52 and the commencement of extension 54. Clearly, this cannot be done because these two indicia number designate different portions of the same unitary part as depicted in the drawings.

The unity between the post 52 and the arm 54 is further reinforced by the subsequent discussion in the Specification of the use of the table 11 in conjunction with the pedestal 50 on page 8 line 10 to 13 which states: "If, on the other hand, the table requirements of the second game differ greatly from those of the first game, a pedestal and canopy 56 suitable for use with the table of the second game can be substituted for that used with the first game." In view of the forgoing, the applicant submits that the rejection of claims 1 and 10 and the amendment to the text under 35 USC 112 must be reversed.

The applicant has submitted an amendment herewith that amends Fig. 1 to add indicia number 55 and to redirect the arrow from indicia number 50 towards the entire structure supporting the canopy so as to be consistent with the Specification. The amendment is not a request to reopen the prosecution of the application. The applicant does not want the present appeal to be dismissed.

For the reasons set forth above, the applicant believes that all the rejections, including the New Grounds for Rejection, are not well founded and should be reversed.

Respectfully submitted,

A handwritten signature in black ink that reads "Robert L. Marsh". The signature is written in a cursive, slightly slanted style.

Robert L. Marsh
Attorney for the Applicant
Registration No. 25894
630-681-7500
630-681-3464 (fax)

54 Danada Drive
P. O. Box 4468
Wheaton, Illinois 60187-4468

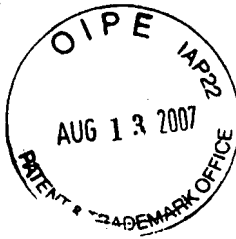


EXHIBIT A

DECLARATION

I, Anthony C. Parra, declare as follows:

That I am one of the inventors of the Casino Gaming Station, filed in the U.S. Patent and Trademark Office on February 13, 2002 and assigned serial no. 10/075,082.

That I have been employed in the gaming and casino industry on a continuous basis (except for the years 1985 to 1988) from 1977 until 2001 during which time I served as a casino table dealer, a casino supervisor, slot operations manager, and casino shift manager having supervisory authority over all casino operations.

That I am familiar with the surveillance techniques employed in the casino industry including several of the types of cameras and the mountings for such cameras used in the casino industry.

That it is my belief that the mounting of a camera on a pedestal having a fixed upwardly extending member and a fixed arm that extends over a gaming table as claimed in my above mentioned patent application has not been used in a casino prior to my invention.

That cameras have been used to provide surveillance in the casino industry since circa 1970 or before.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application of any patent issued thereon.



Anthony C. Parra



Date

EXHIBIT B

Amendment to Specification Submitted August 13, 2004

Please amend the second paragraph of page 6 of the specification as follows:

Positioned near the table 11 is a pedestal 50 supporting an upwardly extending vertical post 52, the upper end of which supports a horizontally outwardly extending portion 54 at the end of which is a canopy 56. ~~Although the~~ The pedestal 50 is depicted in Fig. 1 as a unitary member having an arcuate configuration extending from the post 52 to the horizontal extension 54, however, the post 52 and extension 54 may have any of a number of configurations within the spirit of the invention. The pedestal 50 is provided with a base 55 having sufficient weight and has sufficient width 58 to adequately support the canopy 56 over the center of the upper surface 16 of the table 11 while the pedestal 50 is positioned sufficient far from the base 12 of the table 11 so as to not interfere with the activities of the patrons or the dealer who are engaged in the play of the game. The canopy 56 has an outer surface 60 which is provided with an LED display, or any other means, for projecting advertising material which can be seen by patrons passing the casino game station 10.

Fig. 1

